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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,243	06/22/1999	SCOTT D. MAURER	30349	8744

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HAHN LOESER & PARKS, LLP
TWIN OAKS ESTATE
1225 W. MARKET STREET
AKRON, OH 44313

EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 10/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,243

Applicant(s)

MAURER, SCOTT D.

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 51-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 51-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Information Disclosure Statement

1. The information disclosure statement filed July 12, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicant has failed to provide a date of publication for the reference "Outwater Plastics Industries" listed under 'Other Documents'. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).

The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. See MPEP § 609 A(1).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 51-58, 65, 66, 73, and 74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to have originally presented a molding possessing a front surface profile of "chair rail molding". Nor, does the specification appear to have originally presented a molding possessing a front surface profile of "base molding".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 appears dependent upon a canceled claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 6, 7, 59, 60, 62, 67, 68, and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. Johnson et al. discloses, Figs. 1, 3, 5, and 7, a molding formed of a flexible polyurethane plastic foam member 14 having a front and rear side with a pressure sensitive adhesive 16 affixed to a rear side thereof with a release strip 18 covering the adhesive layer. The molding of Johnson being rollable along a length thereof into a coil. The Johnson et al. molding has the capability of being installed at an intersection between a wall and a ceiling or at an intersection between a wall and a floor or along a wall surface. The surface of member 14 being treated with a corona discharge to enhance adhesion of any adjoining layer, col. 9, lines 18-19.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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9. Claims 6, 7, 59, 60, 62, 67, 68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. in view of Johnson et al.

Hayashi et al. discloses a molding formed of a flexible polyurethane or polyethylene plastic foam member 12 having a front and rear side with a pressure sensitive adhesive 2 affixed to a rear side thereof with a release agent covering the adhesive layer. The molding of Hayashi et al. being rollable along a length thereof into a coil. The Hayashi et al. molding has the capability of being installed at an intersection between a wall and a ceiling or at an intersection between a wall and a floor or along a wall surface. The surface of member 12 being treated with a corona discharge to enhance adhesion of any adjoining layer, col. 3, lines 50-56. Johnson et al. teaches utilization of a release layer 18 upon adhesive layer 16. To have provided the Hayashi et al. molding with a release layer upon the adhesive layer 2 in place of a release agent, thus affording protection from contaminants as well as allowing for formation of a wound body, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made in view of Johnson et al.

10. Claims 6, 7, and 59-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of either of Hayashi et al. or Johnson et al.

Johnson discloses, Figs. 2, 3, and 5, a molding formed of a flexible polyvinyl plastic foam member 12/16/17 having a front and rear side with a pressure sensitive adhesive 19 affixed to a rear side thereof, Fig. 2 or 3 showing adhesive along a “top” portion and “bottom” portion, (or

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“first layer oriented about perpendicular to...[a] second layer”), with a release strip 20 covering the adhesive layer. The Johnson molding possessing any decorative cross section, col. 4, lines 60-62. A “crown” molding effect can be seen in Fig. 2 with a “cove” molding effect shown in Fig. 3. The “molding” of Johnson being rollable along a length thereof into a coil. The Johnson molding can be installed at an intersection between a wall and a ceiling or at an intersection between a wall and a floor or along a wall surface.

Each of Hayashi et al. and Johnson et al. teach application of corona primer treatment to a foam member so as to enhance adhesion of any adjoining layer. To have pre-primed or corona treated the Johnson foam member 12/16/17, thus enhancing adhesion of any adjoining layer such as the adhesive layer 18 or 19, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made in view of either of Hayashi et al. or Johnson et al. To have formed the resulting Johnson member 112/16/17 of a plastic foam rubber material such as a rubber latex, polyurethane or a polyethylene foam, thus affording the desired properties of Johnson with a well known and highly utilized cost effective material, would have constituted a further obvious expedient to one of ordinary skill in the art.

11. Claims 8, 51-58, and 75-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of either of Hamlin or Morris et al.

Johnson discloses, Figs. 2, 3, and 5, a molding formed of a flexible polyvinyl plastic foam member 12/16/17 having a front and rear side with a pressure sensitive adhesive 19 affixed to a

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rear side thereof, Fig. 2 or 3 showing adhesive along a "top" portion and "bottom" portion, (or "first layer oriented about perpendicular to...[a] second layer"), with a release strip 20 covering the adhesive layer. The Johnson molding possessing any decorative cross section, col. 4, lines 60-62. The "molding" of Johnson being rollable along a length thereof into a coil. The Johnson molding can be installed at an intersection between a wall and a ceiling or at an intersection between a wall and a floor or along a wall surface.

Each of Hamlin and Morris et al. teach application of roll forming to a flexible building stock material so as to allow for ease of handling and delivery. To have formed or packaged the Johnson foam member 12/16/17 in a roll, thus permitting ease of handling and delivery, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made in view of either of Hamlin or Morris et al. To have formed the resulting Johnson member 112/16/17 of a plastic foam rubber material such as a rubber latex, polyurethane or a polyethylene foam, thus affording the desired properties of Johnson with a well known and highly utilized cost effective material, would have constituted a further obvious expedient to one of ordinary skill in the art.

12. Claims 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Freeman.

Freeman discloses a building stock material formed of a foam material having a density of from about 1 to about 25 pounds per cubic foot, col. 2, lines 7-9. To have formed the Johnson

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et al. member 14 of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art as taught by Freeman.

13. Claims 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. in view of Johnson et al. as applied to claims 6, 7, 59, 60, 62, 67, 68, and 70 above, and further in view of Freeman.

Freeman discloses a building stock material formed of a foam material having a density of from about 1 to about 25 pounds per cubic foot, col. 2, lines 7-9. To have formed the modified Hayashi et al. member 12 of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art as taught by Freeman.

14. Claims 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of either of Hayashi et al. or Johnson et al. as applied to claims 6, 7, and 59-74 above, and further in view of Freeman.

Freeman discloses a building stock material formed of a foam material having a density of from about 1 to about 25 pounds per cubic foot, col. 2, lines 7-9. To have formed the modified Johnson member 12/16/17 of a foam having a density of less than 9 lbs./cu. ft., thus providing a


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member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art as taught by Freeman.

15. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of either of Hamlin or Morris et al. as applied to claims 8, 51-58, and 75-84 above, and further in view of Freeman.

Freeman discloses a building stock material formed of a foam material having a density of from about 1 to about 25 pounds per cubic foot, col. 2, lines 7-9. To have formed the modified Johnson member 12/16/17 of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art as taught by Freeman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354

M. Safavi
October 15, 2002